

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of) **MAIL STOP AF**
Lina Strand Backman) Group Art Unit: 3627
Application No.: 10/667,449) Examiner: Paul Danneman
Filed: September 23, 2003) Confirmation No.: 9444
For: METHOD AND APPARATUSES)
FOR INFORMING, SURVEYING)
AND MARKETING TO POTENTIAL)
CUSTOMERS)

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant requests that the appeal be maintained despite the appearance of a new grounds of rejection in the Examiner's Answer, under the provisions of 37 C.F.R. 41.41.

The new grounds of rejection is under 35 U.S.C. § 101 suggesting that claims 1-13 and 17-20 do not recite the patent-eligible subject matter under 35 U.S.C. § 101. Appellant respectfully disagrees.

More specifically, the Examiner rejects claims 1-13 under 35 U.S.C. § 101 suggesting that to comply with 35 U.S.C. 101 the claimed invention "must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing," citing *In re Bilski et al.*, 88 USPQ2d 1385 (CAFC 2008) as well as Supreme Court precedent. Certiorari has been granted in the *In re Bilski* decision and the U.S. Supreme Court is likely to overturn it insofar as it is clearly and unmistakably in contradiction to the U.S. Supreme Court precedent.

With respect to reliance on *In re Bilski*, it is noted that the Supreme Court has repeatedly cautioned: "phenomenon of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work." *Gottschalk v. Benson*, 409 US 63, 67 (1972). In the same case, the Supreme Court was clear in saying:

It is argued that a process patent must either be tied to a particular machine or apparatus or must operate to change articles or materials into a "different state or thing." We do not hold that no process patent could ever qualify if it did not meet the requirements of our prior precedents. It is said that the decision precludes a patent for any program servicing a computer. We do not so hold."

What the Federal Circuit did in *In re Bilski* was basically revise the open-ended language of 35 U.S.C. § 101 (which has been interpreted by the Supreme Court) to be all inclusive except for three narrow exceptions of phenomena of nature, mental processes, and abstract intellectual concepts) to now be given an incredibly narrow and exclusive definition under the "machine or transformation" test articulated but specifically rejected as being the sole test by the Supreme Court in *Gottschalk*, for instance.

Insofar as the Examiner relied on *In re Bilski*, which will almost certainly be overturned by the Supreme Court, Appellant respectfully request reconsideration and withdrawal of this rejection.

It is also noted that the Examiner mischaracterized the claims as "purely mental steps". Claim 1, for instance, recites presenting a potential customer with various "visual presentations". These visual presentations including a visual presentation of a first known product, a second known product and one or more

intermediate visual presentations of at least one of the first or second known products by changing the appearance of at least one characteristic of the first product to more closely resemble that of at least one characteristic of the second product, wherein one of intermediate visual presentations is a visual presentation of a new product. Hence, there are four categories of visual presentations including the first known product, the second known product, and intermediate visual presentation at least one of which is a visual presentation of a new product. These are not abstract intellectual concepts but real life physical visual presentations insofar as one cannot see an abstract concept with the human eye. It is assumed that the Examiner has not gone to the extent of suggesting that a visual presentation in the context of the present application is only in the mind of the beholder.

The Examiner also rejects claims 17-20 under 35 U.S.C. § 101 "because the limitations recite a system *per se* which may be equated to that of interconnected devices which is defined by its physical structural elements and corresponding functionality." These claims are directed to an advertisement and the Examiner's comments have absolutely no bearing or relationship to what is actually being claimed. The Examiner also states that "no physical structural elements are recited, [therefore] the claims are directed to non statutory subject matter." The undersigned knows of no case law or any other authority that would stand for this proposition including *In re Bilski*. The Examiner also states that "The body of the claims comprise software modules, which are virtual modules not physical structures." Again, there is no software expressly recited in these claims and it cannot be understood how one could suggest that these claims are unpatentable (or for that matter that software modules are unpatentable since when compiled they are

software as compiled hardware reconfigures hardware that unmistakably is physical in nature.

Hence, claims 17-20 are clearly patentable insofar as it is apparent the Examiner has completely misunderstood the claims and has not presented a *prima facie* case of unpatentability insofar as this misunderstanding has resulted in the rejections being critically defective as to supporting rationale.

Claims 17-20, which have been very strongly mischaracterized by the Examiner, also recite these visual presentations of a first known product, a second known product, a plurality of intermediate visual presentations at least one of which is that of a new product and of course it is an advertisement insofar as there is an identification of the source of a new product. Again, these are not abstract intellectual concepts and it is assumed that the Examiner would not view them as either a phenomena of nature or mental processes.

For at least the foregoing reasons, Appellant respectfully submits that the rejection under 35 U.S.C. § 101 should be overturned on the claims indicated to include patentable subject matter.

At page 10 of the Examiner's Answer, the Examiner provides his comments on Appellant's arguments. With all do respect, it appears that the Examiner is simply restating his earlier positions. The Examiner is only identifying that the surveys articulated in Jain paragraphs [0024, 0064 and 0104 and 0174] speak of "predefined objectives" of a survey being "new product acceptance", "desired feature enhancement to a product", "advertisement highlighting the two product attributes", and "advertisement of a similar or the new product" as well as "comparison with other products, etc.". It is not surprising a survey would discuss new products and

comparing the new products but the content or object of a survey is hardly the same thing as the specific recitations of claim 1, for instance, which in certain embodiments basically morphs a first known product to more closely resemble a second known product, but results in an intermediate image of a visual presentation of the new product. This way, one in casually reviewing the advertisement could understand by analogy of the known products what the new product design features offers. Simply asking questions about product acceptance and comparison does not come close to the novel and unobvious mechanism for enabling potential consumers to visually understand the products' attributes from known products due to a morphing of one or both of two known products into a visual presentation of the new product.

At page 11 of the Examiner's Answer, the Examiner points out that he did not suggest modifying the prior art in his rejection. The Examiner is saying Appellant's invention is "equivalent" which does not make sense. This seems to be an admission the present invention is not present in the prior art, and that the Examiner has not envisioned how one skilled in the art would have modified the applied art to meet the claim recitations.

Also, the Examiner has misunderstood the present claim recitations with respect to the Jain patent. The undersigned has pointed out that to reach the claim recitations a modification is necessary. Therefore, because the Examiner did not identify that the modification was necessary, he also did not supply reasons, teachings or suggestions for doing so. As such, because such modification is actually necessary, and a *prima facie* case of obviousness requires the Examiner to provide reasons, teachings or suggestions for the modification, the rejection fails.

See, e.g., *KSR International Co. v. Teleflex Inc.* (KSR), 550 U.S. ___, ___, 82 USPQ 2d 1385, 1395 (2007).

At page 12, the Examiner suggests that "product comparisons" and "advertisement(s) of a similar product or the new product" meet the concern with presenting an intermediate visual presentation of a new product, where the new product has at least one characteristic of the first known product changed to more closely resemble at least one characteristic of the second product, as recited in claims 2, 11 and 18. Again, it is respectfully submitted that the Examiner is misunderstanding the claims. Simply providing side-by-side comparisons of products would not meet the recitations of intermediate visual presentations of a new product based on a first known product that is changed to more closely resemble at least one characteristic of the second product.

At page 13, the Examiner responds to Appellant's point that the secondary reference (Zawilinski) that, even if a proper hypothetical combination of Zawilinski could be made with Jain, the hypothetical result would still not meet the recitation of "a plurality of intermediate visual presentations of products are still images" and/or "are at least one of moving images and animations.". The Examiner's pointing to paragraphs [0024, 0028 and 0032] of Jain does not make immediate sense to the undersigned with respect to the historical responses to research designs with respect to a given incentive whereas the other citations to paragraphs [0040] and [0048] regard a customer's response to advertisements. While it is accurate to say Zawilinski deals with visually displaying one or more stimuli at a given time interval to measure emotional responses elicited thereby in human beings, would still not involve the "intermediate visual presentations of products as articulated in an

application" as recited in the context of the current claims. The Examiner is simply choosing something that involves video and suggesting that somehow the mere involvement of video would make an obvious modification to a survey. Even if there were true, it would still not result in the claim recitations for the reasons articulated above.

In light of the foregoing, Appellant respectfully submits that the Examiner's final rejection be overturned and the application returned to the Examiner for prompt issuance.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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By: William C. Wieland, RN 30888, for
Charles F. Wieland III
Registration No. 33096

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620